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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/621,793	07/16/2003	Chris Felcman	200302235-2	1457

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EXAMINER

NOVOSAD, JENNIFER ELEANORE

ART UNIT	PAPER NUMBER
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3634

DATE MAILED: 02/25/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/621,793

Applicant(s)

FELCMAN ET AL.

Examiner

Jennifer E. Novosad

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 July 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-59 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-59 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 16 July 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 11282003.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

This Office action is in response to the application filed July 16, 2003 and the preliminary amendment filed November 28, 2003 by which claims **23**, **33**, and **41** were amended and claims **51-55**, **56**, **57**, **58** and **59** were added.

Priority

This application filed under former 37 CFR 1.60 lacks the necessary reference to the prior application. A statement reading "This is a continuation of Application No. 09/873,947, filed June 4, 2001, now abandoned." should be entered following the title of the invention or as the first sentence of the specification. Also, the current status of all nonprovisional parent applications referenced should be included.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims **41-44** are rejected under 35 U.S.C. 102(b) as being anticipated by Foster *et al.* '617.

Foster *et al.* '617 show the structure capable of performing the method steps of: providing a computer having a housing approximately one inch thick (see column 7, line 16), i.e., less than 1/2U in a closed configuration and inherently capable of being mounted in a 1U

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thick rack space, comprising a flat display panel rotatably attached, by a hinge, to an input device, i.e., keyboard having a trackball (see column 7, line 3) or pointing device whereby the display panel is less than 1/2U, i.e., 7.5mm, and the input device, i.e., the keyboard, is less than 3/4 U thick. With respect to the recitation "a rack mountable assembly" (in line 5 of claim 41), it is noted that the structure of Foster *et al.* '617 is inherently capable of forming such an assembly. *For example*, if a book shelf unit were called a rack and then the structure of Foster *et al.* '617 were placed on one of those shelves, the structure would then be a "rack mountable assembly". It is noted that the claims do not define, in any way, what defines the rack even though it is functionally recited. *Thus*, the afore-mentioned example is considered to be a broad interpretation of the "rack mountable assembly" recitation.

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

Claims 56 and 57 are rejected under 35 U.S.C. 102(e) as being anticipated by Sikat *et al.* '453 (U.S. Patent Publication Application).

Sikat *et al.* '453 show a computer whereby the display (generally at 11) is nested (see Figure 2) within the keyboard (at 12) in a clamshell configuration whereby the computer is opened and closed when needed. It is noted that the claims are only positively claiming the interaction assembly and not the rack, nor the rack space (defined in line 4 of claim 56) and thus the computer of Sikat *et al.* '453 is considered to be capable of being "mountable", as called for in line 4 of claim 56.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-6, 8-14, 15-21, 33-37, 47, and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harwell '590 in view of Foster *et al.* '617.

Harwell '590 disclose rack mount computing system comprising a user interaction assembly mountable in a rack space defined in the system whereby the rack space is 2U thick, i.e., the space is capable of holding a 1U or less computer assembly therein, and the user interaction assembly comprises an input device, i.e., a keyboard having scroll buttons and computing circuitry, that is rotatably disposed adjacent a display panel (20); a the user interaction assembly further comprises a component housing (32) defining a video controller for the circuitry. Harwell '590 is considered to teach the method steps of disposing a keyboard in a rack space in a server rack, providing a graphical coordination device adjacent the keyboard, slidably removing the keyboard from a space in the rack and rotatably opening the display. *With respect to claim 40*, Harwell '590 is considered to show structure capable of performing the method steps of providing an open configuration for operation of the keyboard with the display being partially withdrawn from the space.

The claims differ from Harwell '590 in requiring: (a) the assembly to comprise an assembly mountable in a 1U space and comprising an input device and panel display (claims 1, 15, 33, and 47) that are disposed in a clamshell configuration (claim 15); (b) the keyboard to

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have a trackball (claim 4), (c) the assembly to be approximately 17.5 inches (claims 10, 11, and 20) wide and 19.25 inches deep (claim 12), and (d) the panel to be less than 1/2U thick (claims 13, 20, 36, and 41) and the input device to be less than 3/4U thick (claims 14, 21, 35, and 41).

Foster *et al.* '617 teach a computer having a housing approximately one inch thick (see column 7, line 16), i.e., less than 1/2U and inherently capable of being mounted in a 1U thick rack space, i.e., since the computer is less than 1U thick it would fit in a space that is 1U thick, comprising a flat display panel rotatably attached, by a hinge, to an input device, i.e., keyboard having a trackball (see column 7, line 3) whereby the display panel is less than 1/2U, i.e., 7.5mm, and the input device is less than 3/4 U thick. The way in which the display lies adjacent the keyboard and is pivoted at a hinge thereon, the computer of Foster *et al.* '617 is considered to define a clamshell configuration.

With respect to (a), (b) and (d), it would have been obvious to one of ordinary skill in the art at the time the invention was made to have utilized a computer having a trackball and a thickness less than 1U, as taught by Foster *et al.* '617, with the rack mount of Harwell '590, for increased storage capabilities due to the decreased thickness and ease in assembly, since the less than 1U thick computer would fit in a 1U thick space.

With respect to (c), although Foster *et al.* '617 is silent as to the width and depth of the computer, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have had a computer having the specified dimensions, for increased storage capabilities.

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Claims 7, 51, 52, 22, 53, 38-40, 48, and 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harwell '590 in view of Foster *et al.* '617 as applied to claims 1-6, 8-14, 15-21, 33-37, 47, and 50 above, and further in view of Sikat *et al.* '453.

The claims differ from the above references in requiring: (a) the display panel to be nested within the input device (claims 6 and 7), and (b) the method step of opening and closing the nesting.

With respect to (a) and (b), Sikat *et al.* '453 teach a computer whereby the display (at 11) is nested (see Figure 2) within the keyboard (at 12) in a clamshell configuration whereby the computer is opened and closed when needed.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided a computer having a nesting capability for increased safety and securement of the display panel.

Claims 23-26, 28-32, and 58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harwell '590 in view of Baddour *et al.* '033 and Foster *et al.* '617.

Harwell '590 discloses the system as advanced above.

The claims differ from Harwell '590 in requiring: (a) the rack structure to have a plurality of spaces (claims 23 and 58), (b) the assembly to be between 10.5 and 20 inches (claim 29) wide, (c) the panel to be less than 1/2U thick (claim 30) and the input device to be less than 3/4U thick (claim 31), and (d) the input-display assembly to define a clamshell configuration (claim 58) that fits within a 1U thick rack space (claim 58).

With respect to (a), Baddour *et al.* '033 teach an arrangement comprising a plurality of rack spaces into which computers are placed.

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It would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided the system of Harwell '590 with a plurality of spaces, for increased storage capacity and capabilities.

With respect to (b), although Foster *et al.* '617 is silent as to the width and depth of the computer, it would have been obvious to one of ordinary skill in the art at the time the invention was made to have had a computer having the specified dimensions, for increased storage capabilities.

With respect to (c) and (d), Foster *et al.* '617 teaches a one inch thick, i.e., less than 1/2U, computer comprising a flat display panel rotatably attached, by a hinge, to an input device, i.e., keyboard (as further advanced above).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have utilized a computer having a trackball and a thickness less than 1U, as taught by Foster *et al.* '617, for increased storage capabilities due to the decreased thickness and ease in use to the consumer.

Claims 27, 54, 55, and 59 are rejected under 35 U.S.C. 103(a) as being unpatentable over Harwell '590 in view of Foster *et al.* '617 and Baddour *et al.* '033 as applied to claims 23-26, 28-32, and 58 above, and further in view of Sikat *et al.* '453.

The claims differ from the above references in requiring the display panel to be nested within the input device.

Sikat *et al.* '453 teach a computer whereby the display (at 11) is nested (see Figure 2) within the keyboard (at 12) in a clamshell configuration whereby the computer is opened and closed when needed.

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It would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided a computer having a nesting capability for increased safety and securement of the display panel.

Claim 45 rejected under 35 U.S.C. 103(a) as being unpatentable over Foster *et al.* '617 as applied to claims 41-44 above, and further in view of Sikat *et al.* '453.

Foster *et al.* '617 disclose the computer as advanced above.

The claim differs from Foster *et al.* '617 in requiring the display to be nested in the keyboard.

Sikat *et al.* '453 teach the computer as advanced above.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have provided a computer having a nesting capability for increased safety and securement of the display panel.

Claim 46 rejected under 35 U.S.C. 103(a) as being unpatentable over Foster *et al.* '617 as applied to claims 41-44 above, and further in view of Harwell '590.

Foster *et al.* 617 disclose the computer as advanced above.

The claim differs from Foster *et al.* '617 in requiring the step of coupling a linear positioning structure to the assembly.

Harwell '590 teaches the structure capable of performing the method step of coupling a linear positioning structure (generally at 32) to an assembly having a display panel and an input device.

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It would have been obvious to one of ordinary skill in the art at the time the invention was made to have coupled the computer of Foster *et al.* '590 to a positioning structure for ease in assembly and use to the consumer.

Response to Arguments

Applicant's arguments filed November 28, 2003 have been fully considered but they are not persuasive.

Applicants' arguments (see page 12) that "the cited reference [Foster *et al.*] does not disclose... 'rotatably coupling the display and keyboard to form a *rack mountable assembly* having a 1U or thinner thickness'... in contrast... the cited reference discloses a *laptop or portable computer*" and that "the *portability or mobility* of Foster *et al.* is antithetical to the *rack mountability*", are acknowledged (note also applicants' arguments concerning the Sikat *et al.* reference on the top of page 6).

Firstly, regarding claim 41 and the Foster *et al.* reference, it is noted Foster *et al.* disclose an assembly, i.e., a portable computer, that is 1 inch thick, i.e., less than 1U thick and hence these limitations of the claim are clearly met. *Further*, it is noted that claim 41 does not recite that the assembly is "mounted", i.e., positively, in any manner to any structure; that is, the claim is only reciting the structure of the "assembly". The fact that applicants have chosen to refer to the "assembly" as "rack mountable" is irrelevant since there is no structure in the claim that is not in the reference. *Accordingly*, Foster *et al.* are still considered by the examiner to meet the limitations of the claims.

Secondly, regarding the Foster *et al.* (claim 41) and the Sikat *et al.* (claim 56) references, it is noted that the mere fact that the assemblies of Foster *et al.* and Sikat *et al.* are "portable" is considered to be more limiting than what is actually being claimed and therefore is not commensurate with the scope of the claims. *In particular*, the claims recite the limitation "mountable" which is functional and do not in any way positively link the claimed structure to "rack space". *Further*, the claims do not require that the assembly be adapted to be "permanently" mountable or "immovably" mountable. In fact, the specification of the instant application (see page 6, lines 10-15) recites that the devices may be "fixedly or movably coupled to the rack". In view of the claims and specification, since a rack is not being positively claimed in claims 41 and 56, the "portability" of Foster *et al.* and Sikat *et al.* is considered to not be commensurate with the scope of the claims.

With respect to the Sikat *et al.* '453 reference and applicant's remarks (see page 14) concerning the Rule 131 Declaration, it is noted that there is no record of such a paper being filed in this application and thus these arguments are considered to be moot, at this time. *Further*, it is noted that no record of Rule 132 declarations, as discussed on pages 21-24, and thus these arguments are moot, at this time.

Regarding the Varghese *et al.* reference, this reference has not been utilized in any rejection in this application.

It is noted that applicant's arguments, such as "the Examiner's argument... is 'merely functional', is an insufficient reason to ignore the limitation" (see the last sentence of the second full paragraph on page 19), are acknowledged. *However*, these limitations, to which applicant refers, have not been "ignored" but rather have been given no patentable weight. The Examiner

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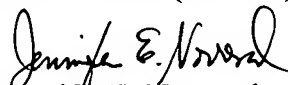
has advanced discussion of certain functional limitations (as seen above) to clarify the applied references with respect to the rejected claims. This clearly shows that the examiner has not "ignored" these limitations.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer E. Novosad whose telephone number is (703)-305-2872. The examiner can normally be reached on Monday-Thursday, 5:30am-4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Daniel P. Stodola can be reached on (703)-308-2686. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Jennifer E. Novosad
Primary Examiner
Art Unit 3634

Jennifer E. Novosad/jen
February 18, 2004